

REMARKS

Favorable reconsideration and withdrawal of the objections and rejections set forth in the above-mentioned Official Action in view of the foregoing amendments and the following remarks are respectfully requested.

Drawings

Figure 5 is objected to because it does not include a legend such as --Prior Art--.

In response, a Submission of Corrected Sheet of the Drawings is being filed concurrently herewith in which Figure 5 is labeled --PRIOR ART--. No new matter has been added. It is respectfully submitted that the objection to the drawings has been overcome.

Abstract

The Abstract has been amended to place it in better form. It is respectfully submitted that no new matter has been added.

Specification

The specification is objected to because of minor informalities noted by the Examiner. The specification has been amended to attend to the presence of informalities, including those kindly identified by the Examiner. It is respectfully submitted that no new matter has been added.

Claims Status

Claims 1 through 11 are now pending in the application. Claims 1 through 3 and 5 through 7 have been amended to even more succinctly define the invention and/or to improve their form. Claims 9 through 11 have been added to accord Applicants an additional scope of protection commensurate with the disclosure. Support for the new

claims can be found at least with respect to the cleaning device discussed at page 67 of the specification. It is respectfully submitted that no new matter has been added. Claims 1, 6, and 11 are the only independent claims pending in the application.

Claim Objections

Claims 1 and 6 are objected to because of minor informalities kindly noted by the Examiner. In response, Claims 1 and 6 have been amended *inter alia* as proposed by the Examiner to overcome the objection. It is respectfully submitted that the objection to the claims has been overcome.

Allowable Subject Matter

It is acknowledged with appreciation that Claim 5 is merely objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims. The claim remains in its dependent form, inasmuch as it is believed that Claim 1 from which it depends will be found to be allowable.

Art Rejections

Claims 1 and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,332,066 (Yanagawa).

Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yanagawa in view of U.S. Patent Application Publication No. 2001/0051055 (Omata, et al.).

Claims 3 and 7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yanagawa in view of U.S. Patent No. 6,477,339 (Yano, et al.).

Claims 4 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yanagawa in view of U.S. Patent No. 6,336,026 (Heeks, et al.).

The rationale underlying each of the foregoing art rejections is succinctly set forth in the Official Action.

Response to Art Rejections

The rejections are respectfully traversed.

Amended Claim 1 calls for an image forming apparatus that includes an image carrying member; and an intermediate transfer body in an endless shape movable and receivable of toner images from the image carrying member at first and second transfer positions. A toner image formed on the intermediate transfer body is transferred onto a transfer material after passing the first transfer position and the second transfer position again. The first transfer position is a position for transferring to the intermediate transfer body from a nearest image carrying member on a downstream side in a moving direction of the intermediate transfer body with respect to a position that the toner image is transferred from the intermediate transfer body to the transfer material. The second transfer position is a position for transferring to the intermediate transfer body from the nearest image carrying member on an upstream side in the moving direction of the intermediate transfer body with respect to a position that the toner image is transferred from the intermediate transfer body to the transfer material. The following relationship is satisfied where a distance from the first transfer position to the second transfer position along the moving direction of the intermediate transfer body is denoted as L_{ab} , a circumference of the intermediate transfer body in the moving direction is denoted as L_r , and a maximum length of the toner image formed on the intermediate transfer body is denoted as L_m : $L_r - L_m \leq L_{ab}$.

Yanagawa discloses an image forming apparatus, wherein a length α relates to a non-image forming length of an intermediary belt and length L_{ab} corresponds to a distance

from a first transfer position to a second transfer position along a moving direction of the belt, as noted by the Examiner.

The claimed invention prevents interference of a first image transfer at a first transfer position and a second image transfer at a second transfer position. More specifically, the present invention prevents a double image being formed at an end part of a first (preceding) image and an initial part of a second (following) image at a first recording position, to efficiently prevent the interference of the two images.

According to amended Claim 1, the length L_{ab} is maintained where no toner image is formed on the intermediate transfer body. It is not necessary to form an initial part of a second image at a first transfer position, when images are formed successively and the end part of the first image is formed at the second transfer position.

Even if L_r minus L_m is smaller than L_{ab} , it is possible to maintain an area where no image is formed larger than the length L_{ab} by moving a position to form a toner image formed on the intermediate transfer body in a downstream direction one by one.

Yanagawa does not disclose that a length L_{ab} is maintained as a distance where no image is formed on the intermediate transfer body. Therefore, depending on the definition for α , the initial part of the second image must necessarily be formed at the first transfer position while the end part of the first image is formed at the second transfer position. In fact, Yanagawa discloses an embodiment, wherein an initial part of a second image is formed at a first transfer position while an end part of a first image is formed at a second transfer position as also noted by the Examiner.

It is respectfully submitted that Yanagawa does not disclose a feature of amended Claim 1 and therefore does not anticipate the claimed invention.

Similar to the invention of Claim 1, the invention according to each of independent Claims 6 and 11 also prevents interference of a first transfer working at a first transfer position and a second transfer and prevents double image forming of an end part of the first (preceding) image and an initial part of the second (following) image at a first recording position, to efficiently prevent the interference of the two images. Moreover, Claims 6 and 7 even further define the invention over the cited art. For example, Claim 6 also recites that a toner image forming position on the intermediate transfer body is moved on an upstream side in the moving direction of the intermediate transfer body at each image formation where the toner images are formed successively. Claim 11 also recites that a toner image forming position on the intermediate transfer body is moved on an upstream side in the moving direction of the intermediate transfer body so that distance between a first image and a second image is larger than the length L_{ab} at each image forming wherein the images are formed successively.

Omata, et al., Yano, et al., and Hecks, et al. are cited for allegedly disclosing features of the invention recited in certain dependent claims. It is respectfully submitted that these citations do not remedy the above-noted deficiencies of Yanagawa *vis-à-vis* the claimed invention.

It is also respectfully submitted that the combination rejections are not well founded. The Examiner has provided a *rationalization* for combining the teachings of the cited art based on the benefits of doing so. A combination rejection is proper only when there is some suggestion or motivation in the cited art *per se* to cause one having ordinary skill in the art to combine the teachings of the cited art. There is nothing in the cited art which supports the position that it can be combined in the manner suggested. Even if the

art could be so combined, the mere fact that the art can be combined is not sufficient if there is no suggestions in the art that such a combination is desirable. For example, see ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

In view of the foregoing, it is respectfully submitted that independent Claims 1, 6, and 11 are allowable over the cited art whether taken individually or in combination.

Dependent Claims

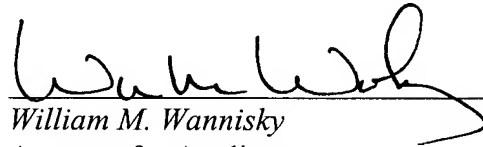
Claims 2 through 5 and 7 through 10 depend either directly or indirectly from one of Claims 1, 6, and 11 and are allowable by virtue of their dependency and in their own right for further defining Applicants' invention. Regarding Claim 2, it seems that the Examiner misunderstands Claim 2. Claim 2 defines a feature wherein every toner image is formed at the same position on the intermediate transfer body and it does not mean that the toner image forming device does not move in the moving direction of the intermediate transfer body. Individual consideration of the dependent claims is respectfully requested.

Closing Comments

It is respectfully submitted that the pending claims are allowable over the art of record and that the application is in condition for allowance. Favorable reconsideration and early passage to issue of the present application are earnestly solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our New York office at the address shown below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Wannisky', written over a horizontal line.

William M. Wannisky
Attorney for Applicants
Registration No. 28,373

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2100

WMW\tas

DC_MAIN 196351v1